

ESTTA Tracking number: **ESTTA540536**Filing date: **05/29/2013**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Design Trademark Holdings, LLC
Granted to Date of previous extension	06/02/2013
Address	3841 N.E. 2nd Avenue Suite 400 Miami, FL 33137 UNITED STATES

Attorney information	Leslie J. Lott Lott & Fischer, PL PO BOX 141098 CORAL GABLES, FL 33114-1098 UNITED STATES ljlott@lottfischer.com, nlajevardi@lottfischer.com, jzambrano@lottfischer.com, sdonna@lottfischer.com Phone:305-448-7089
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Applicant Information

Application No	85676794	Publication date	12/04/2012
Opposition Filing Date	05/29/2013	Opposition Period Ends	06/02/2013
Applicant	City of Doral Suite 100 8300 NW 53rd Street Miami, FL 33166 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 2010/08/00 First Use In Commerce: 2010/08/00
All goods and services in the class are opposed, namely: Promoting the business, commercial, municipal and civic interests of Doral, Florida; promoting business and commercial growth, economic development, community events, and government services in Doral, Florida; providing demographic information via a global computer network about commercial growth, economic and business development services, community events, and government services and employment opportunities in the Doral, Florida

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2700353	Application Date	07/20/2001
Registration Date	03/25/2003	Foreign Priority	NONE

		Date	
Word Mark	MIAMI DESIGN DISTRICT		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 016. First use: First Use: 1999/09/01 First Use In Commerce: 1999/09/01 [Magazine featuring lifestyle and neighborhood activities, home and personal fashion, home furnishings and accessories, art, clothing, landscape design, architecture, flowers, florists, entertainment, restaurants, real estate and shopping]</p> <p>Class 035. First use: First Use: 1995/01/01 First Use In Commerce: 1995/01/01 Promoting the goods and services of others by preparing and placing listings, namely, print and electronic listings, and advertisements in the media, namely, magazines, newspapers, and other print media, radio, television, recorded copies and in a global computer network, and in flyers, books, posters and billboards, in an on-line directory and catalog accessed through a global computer network, and in hard copy, namely, newspapers, magazines, television, radio, and recorded copies, flyers, books, posters, and billboards, in the fields of management, rental, and sale of commercial and residential property, promoting neighborhood activities and awareness, landscape design, architecture, personal and home fashions, art, flowers, florists, entertainment, clothing, restaurants, home furnishings and accessories, and shopping</p> <p>Class 042. First use: First Use: 2001/11/01 First Use In Commerce: 2001/11/01 Computer services, namely providing an on-line magazine in the fields of lifestyle and neighborhood activities, home and personal fashion, home furnishings and accessories, art, clothing, landscape design, architecture, flowers, florists, entertainment, restaurants, real estate, and shopping</p>		

Attachments	05.29.13 [FINAL] Notice of Opposition - DDD DORAL DESIGN DISTRICT.pdf(112785 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/Leslie J. Lott/
Name	Leslie J. Lott
Date	05/29/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Design Trademark Holdings, LLC, a
Delaware limited liability company,
Opposer,

v.

City of Doral, a Florida municipal
corporation,
Applicant.

Opposition No.: _____
Application Serial No.: **85/676,794**

Date of Publication: December 4, 2012

Mark: **D D D DORAL DESIGN
DISTRICT and Design**

NOTICE OF OPPOSITION

Opposer, Design Trademark Holdings, LLC (“Opposer”), a Delaware limited liability company, located and doing business at 3841 NE 2nd Avenue, Suite 400, Miami, Florida 33137, believes it will be damaged by registration of Application Serial No. 85/676,794 (the “Opposed Application”), and, pursuant to 15 U.S.C. § 1063(a) and TBMP § 303.01, hereby opposes same.

As grounds for opposition, Opposer alleges:

1. Upon information and belief, the City of Doral (“Applicant”), a municipal corporation existing under the laws of the State of Florida, located and having its government offices at 8300 NW 53rd Street, Doral, Florida 33166, filed the Opposed Application on July 13, 2012, for the mark **D D D DORAL DESIGN DISTRICT and Design** (“Applicant’s Trademark”).

2. Applicant seeks registration of the Opposed Application on the Principal Register based on the purported use of Applicant’s Trademark in commerce in connection with the following services:

Promoting the business, commercial, municipal and civic interests of Doral, Florida; promoting business and commercial growth, economic development, community events, and government services in Doral, Florida; providing demographic information via a global computer network about commercial growth, economic and business development services, community events, and government services and employment opportunities in the Doral, Florida, in International Class 035.

3. In the Opposed Application, Applicant claims Applicant's Trademark was first used in commerce by Applicant at least as early as August 2010.

4. Opposer believes that it will be damaged by registration of Applicant's Trademark.

5. Opposer is the owner of United States Trademark Registration No. 2,700,353 registered March 25, 2003 for the mark **MIAMI DESIGN DISTRICT and Design** ("Opposer's Registration") in respect of:

a. Promoting the goods and services of others by preparing and placing listings, namely, print and electronic listings, and advertisements in the media, namely, magazines, newspapers, and other print media, radio, television, recorded copies and in a global computer network, and in flyers, books, posters and billboards, in an on-line directory and catalog accessed through a global computer network, and in hard copy, namely, newspapers, magazines, television, radio, and recorded copies, flyers, books, posters, and billboards, in the fields of management, rental, and sale of commercial and residential property, promoting neighborhood activities and awareness, landscape design, architecture, personal and home fashions, art, flowers, florists, entertainment, clothing, restaurants, home furnishings and accessories, and shopping, in International Class 035; and

b. Computer services, namely providing an on-line magazine in the fields of lifestyle and neighborhood activities, home and personal fashion, home furnishings and accessories, art, clothing, landscape design, architecture, flowers, florists, entertainment, restaurants, real estate, and shopping, in International Class 042.

6. Opposer has made use in commerce of the mark **MIAMI DESIGN DISTRICT and Design** ("Opposer's Trademark") in respect of:

a. Promoting the goods and services of others by preparing and placing listings, namely, print and electronic listings, and advertisements in the media, namely,

magazines, newspapers, and other print media, radio, television, recorded copies and in a global computer network, and in flyers, books, posters and billboards, in an on-line directory and catalog accessed through a global computer network, and in hard copy, namely, newspapers, magazines, television, radio, and recorded copies, flyers, books, posters, and billboards, in the fields of management, rental, and sale of commercial and residential property, promoting neighborhood activities and awareness, landscape design, architecture, personal and home fashions, art, flowers, florists, entertainment, clothing, restaurants, home furnishings and accessories, and shopping, in International Class 035; and

b. Computer services, namely providing an on-line magazine in the fields of lifestyle and neighborhood activities, home and personal fashion, home furnishings and accessories, art, clothing, landscape design, architecture, flowers, florists, entertainment, restaurants, real estate, and shopping, in International Class 042.

7. Opposer's use in commerce of the mark **MIAMI DESIGN DISTRICT and Design** commenced at least as early as January 1, 1995 in connection with the services covered by Opposer's Registration in International Class 035 and at least as early as November 1, 2001 in connection with the services in International Class 042, and such use has been continuous since its commencement.

8. Upon information and belief, Opposer's use of Opposer's Trademark commenced before Applicant's Use of Applicant's Trademark and Opposer is therefore the senior user.

9. Opposer's Trademark is a well-known and distinctive trademark which Opposer has advertised, promoted, and used since at least as early as January 1, 1995 in connection with the services covered by Opposer's Registration in International Class 035 and at least as early as November 1, 2001 in connection with the services in International Class 042. Based on such long use and promotion, the public has come to readily associate Opposer with the services covered by Opposer's Registration.

10. Applicant's Trademark is confusingly similar in appearance, sound, connotation and commercial impression to Opposer's Trademark. Moreover, the services offered under Applicant's Trademark are highly similar to the services offered under Opposer's Trademark.

11. In view of the similarity of the parties' respective marks and the overlapping nature of the parties' respective services, Applicant's mark so resembles Opposer's mark so as to be likely to cause the public to be confused, mistaken, or deceived into believing that Applicant's services originate from Opposer or are in some way related to, associated with, approved by, or sponsored by Opposer.

12. Accordingly, registration of Applicant's Trademark is barred by the provisions of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in that Applicant's Trademark consists of or comprises a mark which so resembles a mark previously used in the United States by Opposer in respect of related services so as to be likely to cause the public to be confused, mistaken or deceived.

13. Registration of Applicant's Trademark would damage Opposer because the public is likely to attribute the source or sponsorship of Applicant's services to Opposer.

PRAYER FOR RELIEF

WHEREFORE, Opposer respectfully requests that the instant opposition be granted and that Application Serial No. 85/676,794 be denied registration.

Date: May 29, 2013

Respectfully submitted,

LOTT & FISCHER, PL

/Leslie J. Lott/

Leslie J. Lott, Esq.

E-mail: LJLott@lottfischer.com

355 Alhambra Circle, Suite 1100

Coral Gables, FL 33134

P.O. Drawer 141098

Coral Gables, FL 33114-1098

Telephone: (305) 448-7089

Attorney for Opposer

Design Trademark Holdings, LLC

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that the foregoing **NOTICE OF OPPOSITION** was served upon Applicant by delivering true and correct copies of same to Applicant and counsel for Applicant via Federal Express on May 29, 2013 as follows:

City of Doral
8300 N.W. 53rd Street, Suite 100
Doral, FL 33166

Janet Moreira Gamble, Esq.
Stearns Weaver Miller Weissler Alhadeff & Sitterson, P.A.
Museum Tower, Suite 2200
150 West Flagler Street
Miami, FL 33130

Janet Moreira Gamble, Esq.
MAVEN Intellectual Property
5801 Biscayne Boulevard
Miami, FL 33137

/Leslie J. Lott/

Leslie J. Lott, Esq.